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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,763	03/08/2000	Stephen W. Comiskey	53326.000008	1661

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WASHINGTON, DC 20006-1109

EXAMINER
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CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/520,763

Applicant(s)

COMISKEY ET AL.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 58-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 58-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Claims 64 and 72 have been amended.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 19 May 2000 was filed after the mailing date of the application on 8 March 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. And at the Attorney's request, another copy of the signed, two-page IDS is enclosed.

***Response to Arguments***

3. In light of the Attorney's argument on withdrawing the finality of the previous office action mailed 18 June 2003 since one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be overcome by an amendment supplying the missing item, the finality of the 18 June 2003 office action has been withdrawn.
4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response to applicant's argument that McGovern et al. are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, McGovern et al. indicates in Abstract, skill levels of employees and candidates meet the predicted technical requirements. This parallels the inventor's attempt to procure skilled professionals that are needed on a frequent or non-frequent basis depending on the level of value to the customer, that is, the predicted technical resource needs of the customer, and categorizing the employees or candidates based on skills the employees or candidates have that qualifies them to meet the resource needs predicted by the organization or the high-net worth customer as the inventor's invention indicates, in a way that ranks the employees or candidates by their value. Grouping the employees or

candidates further ranks them by their value to the customer. Thus, McGovern et al. solves the same problem eventhough it is nonanalogous art.

6. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

For these reasons, the Examiner's claim rejections under 103 remain.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 58-64,66-72 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran (U.S. PAT. 6430542A), McGovern et al. (U.S. PAT. 5918207A) and The VIP Forum, Fact Brief, Family Services, February 2000(herein The VIP Forum).

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Re claim 58: Moran disclose a computer implemented method for providing personalized financial services to a client, the computer-implemented method comprising:

a depository for receiving client data from the client comprising at least one client goal and a client portfolio(col. 6, lines 5-25, 50-67, col.15, lines 40-col.16,line 25);

a server for assessing the client portfolio based at least in part on the client goal (col. 2, lines 10-25,col. 8, lines 60-67, Figs. 29-30)and

a display for providing services(col. 2, lines 60-67, Figs. 5,7A-B,10-18).

As applied to claims 58,63,66 and 71: Moran does not explicitly disclose classifying service providers in a hierarchical manner from the core service provider group, the affiliated service provider group and the non-affiliated service provider group in response to the received client data;

assigning a plurality of services to a plurality of service provider groups,

wherein whether each service is needed by the client on a frequent basis is determined or whether a level of value to the client is above a predetermined level is determined;

wherein the plurality of services are categorized into a core service provider group, an affiliated service provider group and non-affiliated service provider group based at least in part on the steps of determining wherein the steps of assessing and assigning are performed at a server.

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However, in McGovern et al. (col. 2, lines 45-60) disclose automatic searches of candidates to match customer's needs and presenting the candidates in ranking order relative to the client's needs. Further, as shown by The VIP Forum (pages 6-10) the lead relationship manager determines the professionals the high net worth individual needs and makes these assignments and referrals. Although, it is clear the relationship manager and not the computer is making the assignments. It would have been obvious to one having ordinary skill in the art at the time the invention was made to automate the needs analysis and referral system to include ranking features based frequency of client need especially in customer relationship management systems, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that has accomplished that same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of McGovern et al. and The VIP Forum to obtain a cost-efficient way of providing referrals to various professionals and specialists.

Re claims 59,62,67 and 70: Moran discloses wherein the core service provider group represents services needed by the client on a frequent basis or having a level of value above the predetermined level indicating a primary level of service;

And Moran discloses wherein the core service provider group represents services most common to the client or providing most value to the client(Abstract, col. 2, 1-60).

Re claims 60,61,68 and 69: Moran does not explicitly disclose(s) the claimed provider group represents services needed by the client on an infrequent basis and having a level of value below the predetermined level indicating a secondary level of service;

And wherein the affiliated service provider group represents services that do not fall within the core service provider group and the non-affiliated service provider group indicating an intermediary level of service.

However, in pages 6-10 thereof, The VIP Forum disclose(s) an array of services provided to clients by different parties at varying intervals as needed by the client. Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of The VIP Forum to obtain the benefit of categorizing various service providers in a hierarchical manner.

Re claims 64 and 72: Moran disclose wherein services from the core service provider group are presented to the client.

Moran does not explicitly disclose wherein services from the affiliated service provider group and services from the non-affiliated service provider group are presented after the services from the core service provider group are first presented. However, in the entire document thereof, The VIP Forum disclose(s) an array of service providers in different units of the bank or affiliated or not affiliated with the bank that are provided to high net worth individuals when their needs so dictate. Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of The VIP Forum to obtain a cost advantage in providing services and referrals to various



levels of professionals when clients require to maintain a stronger, long-term client relationship.

Re claims 74 and 75: Moran disclose further comprising one or more of a tool for mining data and a synthetic logic tool for assessing the client portfolio;

And Moran disclose wherein the synthetic logic tool converts data into useful information related to the at least one client goal(Figs. All, col. 2, line 60-col. 3, line 20).

9. Claims 65 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran, McGovern et al. and The VIP Forum as applied to claims 58 and 66 above, and further in view of Bruce Upbin, "Old Money Chasing New", Forbes, June 15, 1998, vol. 161, iss. 12 (herein "Upbin").

Re claims 65 and 73: Moran disclose wherein the services comprise a plurality of asset allocation services; investment management services; investment banking services; banking services; custody services; reporting services; tax advice services; filing of federal, state and local tax statement services; estate planning services; legal services; accounting services; bookkeeping services; record keeping services; financial investment services; managing financial assets services; management and other services related to closely held stock services; international trusts services; real estate service; development and maintenance of education funds services; business succession planning services; issuance of loans, traveler's checks, foreign currency, credit or other banking services(Abstract, Figs. All, col. 2, line 60-col. 3, line 20).

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Moran does not explicitly disclose public relations services; crisis management services; selection and delivery of insurance services; physical security services; personal security services; information security services; lease, purchase or fractional ownership of automobiles, planes, vehicles or yachts services; personal concierge services; bill paying services; coordination and direction of charitable activities services; background checks on personal staff or other parties services; offering of investment opportunities not available to non-clients services; development and execution of debt reduction strategies services; development and maintenance of education funds services; advice and care of minors, invalids, elderly, incompetents or other persons services.

However, The VIP Fourm(entire document) discloses an array of personal financial and personal planning services typical of large family offices. Further, Upbin (entire article) describes yet more services of the multiclient family office that are more personal than financial. Thus, it would have been within the level of ordinary skill in the art to modify the method of Moran by adopting the teachings of The VIP Fourm and Upbin to obtain a full-service multifamily office with full referral capabilities to locate needed professionals.

**10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

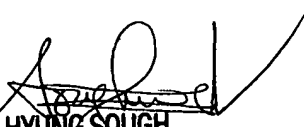
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5771.

Debra F. Charles  
Examiner  
Art Unit 3628

dfc

  
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